



Application No. 10/656,278
Response to Office Action dated November 3, 2006

REMARKS

The claims in this case were restricted into two Groups. Applicants have provisionally elected Group I, Claims 32-58. The Restriction Requirement is traversed.

For restriction to be proper, a burden must be placed on the Office in examining all claims. Applicants respectfully submit that assuming the compositions in Group I and the methods in Group II are materially different, the search for these compositions and methods would occur in the same classes/subclasses given the fact that the compositions in Group I are essentially the same compositions used in the Group II methods. Thus, the compositions are essentially the same compositions used in the Group II methods. Therefore, the same classes/subclasses would be searched because the same compositions are relevant to Group I and Group II claims -- no burden would be placed on the Office in searching and/or examining all claims together. This is particularly true given that the Group II method claims depend from the Group I composition claims. Pursuant to MPEP § 821.04, such dependent method claims should be rejoined in this application upon indication of allowable subject matter. Accordingly, the Restriction Requirement is traversed.

Moreover, Applicants have provisionally elected, for search and examination purposes only, the species of C₂₀-C₄₀ alkyl(hydroxystearyl)stearate (tackifying wax). However, the election of species requirement is traversed.

The reason underlying the designation by the Office of the different structuring agents as being patentably distinct is not explained in sufficient detail or by example, and as such represents only a conclusion, particularly in view of the fact that the identified species are related by operation and/or effect. Accordingly, division of each of these species is unsupported and improper. See, MPEP §§ 802.01 and 806.04 (b).

Application No. 10/656,278
Response to Office Action dated November 3, 2006

Moreover, for an Election of Species requirement to be proper, a burden must be placed on the Office in examining all species. Applicants respectfully submit that no such burden exists in this case.

Applicants respectfully submit that even assuming for the purposes of argument that the structuring agents are materially different from each other, the search for all such structuring agents would occur in the same classes/subclasses. Thus, no burden would be placed on the Office in searching and/or examining all claims together. Accordingly, the Election of Species Requirement is traversed.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor
Attorney of Record
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Tel.: (703) 413-3000
Fax: (703) 413-2220